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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,676	11/20/2003	Donald G. Wheatley	1581-003	7380

26824 7590 06/17/2004

ALEX RHODES  
UNIT NO. 9  
50168 PONTIAC TRAIL  
WIXOM, MI 48393

EXAMINER
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GUTMAN, HILARY L

ART UNIT	PAPER NUMBER
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3612

DATE MAILED: 06/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/716,676

Applicant(s)

WHEATLEY, DONALD G.

Examiner

Hilary Gutman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1-5 and 7-10 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 6 and 11-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 11/20/03.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

1. Applicant's election without traverse of Group I (claim 6 and new claims 11-22) in a paper filed 5/10/04 is acknowledged.
2. Claims 1-5 and 7-10 are hereby withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected group, there being no allowable generic or linking claim. Election was made **without** traverse in a paper filed 5/10/04.

### *Specification*

3. The disclosure is objected to because of the following informalities: on page 4, line 18, "cab 33" should be "cab 13" (both occurrences) to correspond with the drawing figures. Appropriate correction is required.
4. The abstract of the disclosure is objected to because on line 2, "is provided" should be inserted after "truck". Correction is required. See MPEP § 608.01(b).

### *Double Patenting*

5. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

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A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

6. Claim 14 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 12. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

*Claim Rejections - 35 USC § 102*

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 6, 11-15, 17, and 20-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Johnson.

Johnson (4,650,382) discloses a tie-down rail 19, 20 for securing a cargo in a pick-up truck 10 comprising a one-piece body, the body having a tubular shaped upper portion 25, a substantially vertical adjoining downward extending wall portion 22, the downward extending wall portion 22 having a series of apertures 27 (Figure 2) for receiving a rope 33, strap or bungee cord, and an adjoining inward extending horizontal flange portion 21, the inward extending flange portion 21 having a series of apertures 34 for attaching the tie-down rail to the pick-up truck.

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For claim 11, Johnson discloses a tie-down rail 19, 20 (Figure 1) for securing a cargo in a pick-up truck 10 comprising a long slender one-piece body 19, 20 having a length for extending the rail along a substantial portion of a side 15, 16 of a pick-up truck cargo box 12, 14, the body having a closed tubular shaped upper portion 25, a substantially vertical adjoining downward extending wall portion 22, and an adjoining inward extending horizontal flange portion 21.

With regard to claims 12 and 14, a series of apertures 27 are provided in the downward extending wall portion 22 for receiving a rope 33, strap of bungee cord.

With regard to claim 13, the tubular shaped upper portion is a cylindrical tubular portion.

With regard to claim 15, the aperture 27 in the downward extending wall portion are generally rectangular apertures (Figures 2 and 6-7).

With regard to claim 17, a series of apertures 34 are provided in the inward extending flange portion 21 for attaching the tie-down rail to the pick-up truck.

With regard to claim 20, a plurality of bolts 35 and nuts (Figure 5) are provided for attaching the tie-down rail to the pick-up truck.

With regard to claim 21, the long slender one-piece body has opposite downward inclined end portions 36, 37.

For claim 22, Johnson discloses a pair of identical tie-down rails 19, 20 for securing a cargo in a pick-up truck 10, each of the rails comprising along slender aluminum one-piece body having a length for extending the rail along a substantial portion of a side 15, 16 of a pick-up truck cargo box 12, 14, the body having a tubular shaped upper portion 25, a substantially vertical adjoining downward extending wall

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portion 22, a means 27 for receiving a rope 33, strap or bungee cord; and a means 34, 35 for attaching the tie-down rail to the pick-up truck.

With regard to claims 6 and 22, and the limitation "extruded", it should be known that the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process (MPEP 2113).

*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson as applied to claim 11 above, and further in view of Dutton (4,936,724).

With regard to claim 16, Johnson discloses the long slender one-piece body to be a steel body and not an aluminum body.

Dutton teaches a tie-down rail for securing a cargo in a pick-up truck comprising a long slender aluminum body.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have made the steel body of Johnson out of aluminum as taught by Dutton in order to provide a rigid and suitably strong rail which is lightweight and weather-resistant.

With regard to claim 16 and the limitation "extruded", it should be known that the patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process (MPEP 2113).

11. Claims 18-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Johnson as applied to claim 11 above, and further in view of Elwell et al. (6,231,285).

With regard to claims 18 and 19, Johnson lacks the apertures 34 in the inward extending flange portion being for attaching the rail to stake holes in the cargo box side panel with a plurality of rubber bushings, flat washers, bolts and nuts.

Elwell et al. teach a tie-down rail for securing a cargo in a pick-up truck comprising a long slender body and a flange portion 30 (Figures 2-3) wherein the rail is attached to a stake hole 48 in a cargo box side panel (Figure 3). A plurality of rubber bushings 36 are provided as well as flat washers 38, bolts 42, and nuts 40 to secure the rail in position.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the rail of Johnson to be attached to stake holes of the cargo box with a plurality of rubber bushings, flat washers, bolts, and nuts as taught by Elwell et al. in order to prevent unnecessary alterations (or drilled holes) in the vehicle.

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***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hilary Gutman whose telephone number is 703-305-0496.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Dayoan can be reached on 703-308-3102. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

14. **Any response to this action should be mailed to:**

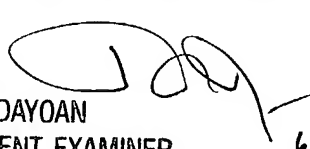
Assistant Commissioner for Patents  
Washington, D.C. 20231

**or faxed to:**

(703) 872-9326, (for formal communications intended for entry)

**or:**

(703) 746-3515, (for informal or draft communications, please clearly label "PROPOSED" or "DRAFT").

  
D. GLENN DAYOAN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600

6/10/04